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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,058	05/18/1999	MICHAEL V. LEMAN	MICE-0026-US	4641

7590

04/07/2004

COE F MILES  
TROP PRUNER HU & MILES PC  
8554 KATY FREEWAY  
STE 100  
HOUSTON, TX 77024

EXAMINER
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EISEN, ALEXANDER

ART UNIT	PAPER NUMBER
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2674

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DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/314,058

**Applicant(s)**

LEMAN, MICHAEL V.

**Examiner**

Alexander Eisen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-33, 36, 38, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-33, 36, 38, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The applicant's amendment after final rejection has been entered.
2. After the thorough consideration of amended claims, the finality of the last Office action has been withdrawn, and new grounds of rejection based on the reference previously cited but not relied upon follow.
3. Claims 31-33, 36, 38, 40 and 41 are pending in present application.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 31-33, 36, 38, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin, US 6,094,341 in view of Robbins, US 5,808,862.

With respect to claims 31, 32, 33 and 38 Lin discloses a computer system and method comprising a separate unit (case base 11 in FIG. 2) containing a keyboard, a first and a second displays (21 and 22), wherein the first and the second display are hingedly connected therebetween and one of the displays is hingedly connected to the base. As can be seen from FIG. 2, both the first and the second displays can be configured to face in first direction and can be folded onto the keyboard so that the second display (22) will be exposed.

Lin does not teach that the second display can be configured as a tablet and adapted to receive a pen-based input or that the first display is a "raster" type display.

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Robbins discloses a convertible notebook computer (FIGS. 1-5), wherein the computer is provided with two modes, one as a regular notebook computer having a keyboard (22) and an LCD display (28), and in another mode as a digitizer, or pen-based input computer (compare to tablet), in which the display is folded over the keyboard and left exposed to receive pen-based input (as in FIG. 4; col. 3, lines 19-39).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to modify the computer system of Lin by an improvement taught by Robbins and make and configure the second display of Lin as a pen-based input computer, because it could be used as a conventional paper notepad and positioned in any convenient and desirable writing orientation to user (Robbins; col. 3, lines 30-34).

As to claim 36, both Lin and Robbins teach computer systems, wherein base units comprise notebook, or laptop computers.

As to claim 40, the base unit is adapted to receive input from the keyboard (both Lin and Robbins teach keyboards).

As to claim 41, as can be seen from FIG. 2 of Lin, both displays can be folded over the keyboard so that the second display (22) is left exposed (see also abstract; col. 1, lines 35-44).

### ***Response to Arguments***

6. Applicant's arguments filed 30 January 2004 have been fully considered but they are not persuasive. Applicant argues that if the second display of Lin were to be adapted to receive a pen-based input Lin would not be easily positioned in any convenient and desirable writing orientation. Applicant also argues that Lin's cover cannot be disregarded and will prevent from convenient position to enter pen-based mode. Examiner respectfully disagrees. Lin's displays 21

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and 22 can be easily folded so that the display 22 is exposed making itself convenient for adapting to a pen-based input, and contrary to applicant's argument the cover 12 will not prevent a user to use the display 22 as a tablet. Would it be very convenient or not is irrelevant, because positioning Lin's computer on the surface as shown in FIGS. 2-3 will keep it in stable condition leaving the cover 12 behind the user's reach without inconveniencing the user. The reason that it would not be easily positioned in any desirable writing orientation would not prevent a user to position it in some desirable or convenient position. It also should be noted that the subject matter in question is not in claims, but all other elements are taught by prior art. The simple fact that a computer is enhanced by the pen-input capability cannot add to patentability of a claim, since tablets and pen-based computers are well known in the art. Therefore the rejection is maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is **(703) 306-2988**. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on **(703) 305-4709**.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

**(703) 872-9306** (for Technology Center 2600 only).

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Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive,  
Arlington, Virginia, Sixth Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone  
number is (703) 306-0377.

A handwritten signature in black ink, appearing to read "Alexander Eisen". The signature is fluid and cursive, with the first name "Alexander" written in a more compact, stylized manner and the last name "Eisen" written more fully.

Alexander Eisen  
April 6, 2004